

REMARKS / ARGUMENTS

The present application includes pending claims 27-64, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 27-34, 37, 38, 53, and 55-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen et al. (Pub. No. WO 2004/016037, hereinafter Chen) in view of Gollmar et al (U.S. Patent No. 4,901,354, hereinafter Gollmar). Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar and further in view of Butler et al (U.S. Patent No. 6,474,816, hereinafter Butler). Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar and further in view of Butler and even further in view of Nestorovic et al (U.S. Patent Publication No. 2004/0155186, hereinafter Nestorovic). Claims 39-47, and 50-52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar and further in view of Warren et al (U.S. Patent No. 7,013,009, hereinafter Warren).

Claim 48 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar in view of Warren and further in view of Butler. Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar in view of Warren in view of Butler and further in view of Nestorovic. Claim 54 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar in view of Warren and further in view of Addeo et al (U.S. Patent No. 5,335,011).

The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. REJECTION UNDER 35 U.S.C. § 103

A. Requirements For A *Prima Facie* Case Of Obviousness

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**. The Federal Circuit has stated that "**rejections on obviousness cannot be sustained with mere conclusory statements**"; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006), and *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d at 1396 (quoting Federal Circuit statement with approval) (emphasis added).

Further, as specifically noted in the MPEP, "[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03 (emphasis added). Further, "**[a]ll words in a claim must be considered** in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.* (emphasis added).

If a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**

See MPEP at § 2142 (emphasis added).

Additionally, “[i]f the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that ... claims are obvious.” See *In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to **some concrete evidence in the record in support of these findings.**” See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

With those principles in mind, the Applicants now turn to the claim rejections, in particular.

B. Rejection of Independent Claims 27, 53, and 55

With regard to the rejection of independent claim 27 under 35 U.S.C. § 103(a), the Applicant first submits that neither Chen, Gollmar, nor a combination of

Chen and Gollmar disclose or suggest at least the limitation of “a transmitter configured to transmit said one or more captured voice signals to one or more external electronic devices,” as recited by the Applicant's independent claim 27. The Examiner points to voice signals 8 and 9 and external device 10 to allegedly teach the “transmitter configured to transmit said one or more captured voice signals to one or more external electronic devices” element of claim 27. However, the Examiner has not pointed to any transmitter. On the contrary, the Examiner points to the wired connection through the connectors 8, 9, and 20 of Chen.

Furthermore, the Applicant submits that Chen in view of Gollmar does not teach “an eyeglass frame having a plurality of **directionally dependent microphones** to capture one or more voice signals,” as recited in the Applicant's claim 27. Instead, Chen teaches an array of microphones across temple bars in an eyeglass hearing aid device, with **beam-forming capability** in the front-facing microphones to exclude sounds from other directions. The Examiner has not explained how this teaches “an eyeglass frame having a plurality of **directionally dependent microphones** to capture one or more voice signals.” The Applicant points out that beam-forming using an array of microphones is not the same as directionally dependent microphones.

Furthermore, the Applicant again submits that combining Chen with Gollmar, or any other microphone references related to capturing bodily vibration sound waves, is improper, as this combination **teaches away from the objective of Chen**, namely a hearing aid device. As indicated by its name, the hearing aid device of Chen is intended to receive audio signals to be amplified and communicated to the

user's ears – it is not intended, or desirable, **to sense the user's voice itself** from captured bodily vibration sounds. The vibration of the deaf user's own skeletal frame is the one element of hearing that a deaf person already has, so there would be no reason to make such a combination of Chen and Gollmar.

Gollmar is cited merely to show capturing bodily sound waves, and the Examiner then makes the conclusory statement that "Since it is a [sic] common knowledge that the eyeglass frame rests on the user via the ear engaging portion of the frame, one of ordinary skill in the art would recognize this common knowledge to place the second microphone on the ear engaging portion so it can contact the human body." Because there is no explicit support for this in Chen or Gollmar, the Examiner is stating that it would merely be "common knowledge" to utilize the ear engaging portion of eyeglasses for a second microphone. However, the Applicant points out that Gollmar explicitly shows in FIG. 1, cited by the Examiner, a separate wired mechanism for coupling with the user's neck near the larynx, with this mechanism being wired to *a headset resting on the user's ears*. If it were "common knowledge" to integrate a microphone in the ear engaging portion of eyeglasses, it would certainly be mentioned in the cited art describing a device that rests right in that location, but it does not. Instead, it describes a contact microphone connected by wire to the user's neck near the larynx.

The Applicant submits that the Examiner has not met the requirements of a rejection under 35 U.S.C. 103. Accordingly, independent claim 27 is not unpatentable over Chen in view of Gollmar and is allowable. Independent claims 53 and 55 are similar in many respects to the system disclosed in independent claim 27.

Therefore, the Applicant submits that independent claims 53 and 55 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 27.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 27, 53, and 55.

C. Rejection of Dependent Claims 28-34, 37, 38, and 56-64

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27, 53, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar has been overcome and request that the rejection be withdrawn. Therefore, claims 28-34, 37, 38, and 56-64 depend from independent claim 27, 53, and 55, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 28-34, 37, 38, and 56-64.

D. Rejection of Dependent Claim 35

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27, 53, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar has been overcome and request that the rejection be withdrawn. Butler is cited to for a retinal scanning display. However, Butler does not overcome the deficiencies of Chen and Gollmar described above. Therefore, claim

35 depends from independent claim 27, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 35.

E. Rejection of Dependent Claim 36

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27, 53, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar has been overcome and request that the rejection be withdrawn. Nestorovic is cited to for a detection module that is configured to capture a direction of view. However, Nestorovic does not overcome the deficiencies of Chen, Addeo, and Butler described above. Therefore, claim 36 depends from dependent claim 35 and independent claim 27, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 36.

F. Rejection of Independent Claim 40

With regard to the rejection of independent claim 40 under 35 U.S.C. § 103(a), the Applicant submits that neither Chen, Gollmar, Warren nor a combination of Chen, Gollmar, and Warren disclose or suggest at least the limitation of “adjusting, via a control module, directional dependence of at least a first

directionally dependent microphone of said plurality of directionally dependent microphones based on said one or more voice signals captured by said first directionally dependent microphone and at least a second directionally dependent microphone of said plurality of directionally dependent microphones; wherein said second directionally dependent microphone is positioned for capturing bodily vibration sound waves,” as recited by the Applicant in amended independent claim 40.

As stated previously, Chen teaches an array of microphones across temple bars in an eyeglass hearing aid device, with *beam-forming capability* in the front-facing microphones to exclude sounds from other directions, not directionally-dependent microphones. Furthermore, the Applicant submits that combining Chen with Gollmar, Warren, or any other microphone references related to capturing bodily vibration sound waves, which is not taught in Chen, is improper, as this combination teaches away from the objective of Chen, namely a hearing aid device. As indicated by its name, the hearing aid device of Chen is intended to receive audio signals to be amplified and communicated to the user’s ears – it is not intended, or desirable, to sense the user’s voice itself from captured bodily vibration sounds.

Warren is cited to merely to for wireless communication. However, Warren does not overcome the deficiencies of Chen and Gollmar.

Accordingly, independent claim 40 is not unpatentable over Chen in view of Gollmar and further in view of Warren and is allowable. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 40.

G. Rejection of Dependent Claims 39, 41-47, and 50-52

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27, 53, and 55 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar and claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar and further in view of Warren has been overcome and request that the rejection be withdrawn. Therefore, claims 39, 42-47, and 50-52 depend from independent claims 27 and 40, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 39, 42-47, and 50-52.

H. Rejection of Dependent Claim 48

Based on at least the foregoing, the Applicant believes the rejection of independent claim 40 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar and further in view of Warren has been overcome and request that the rejection be withdrawn. Butler is cited to for an integrated retinal display. However, Butler does not overcome the deficiencies of Chen, Gollmar, and Warren as described above. Therefore, claim 48 depends from independent claim 40, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 48.

I. Rejection of Dependent Claim 49

Based on at least the foregoing, the Applicant believes the rejection of independent claim 40 and dependent claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Gollmar in view of Warren and further in view of Butler has been overcome and request that the rejection be withdrawn. Nestorovic is cited to for a detection module that is configured to capture a direction of view. However, Nestorovic does not overcome the deficiencies of Chen, Gollmar, Warren, and Butler as described above. Therefore, claim 49 depends from dependent claim 48 and independent claim 40, and is, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 49.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 27-64 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Patent Agent at (312) 775-8217.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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/Erick J. Michel/
Erick J. Michel
Registration No. 60,928
Attorney for Applicant

MCANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8000